UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/662,752	09/15/2003	Rebecca L. Twigg	CING-124	1547

39013 7590 03/12/2007	**EXAMINER**
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ART UNIT	PAPER NUMBER
2617	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	03/12/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

PTOL-90A (Rev. 10/06)

	Application No.	Applicant(s)
Office Action Summary	10/662,752	TWIGG ET AL.
	Examiner	Art Unit	
	Randy Peaches	2617	

-- *The MAILING DATE of this communication appears on the cover sheet with the correspondence address* --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>*11 December 2006*</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>*4-22*</u> is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>*4-22*</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____.

5)☐ Notice of Informal Patent Application

6)☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. 　　*Claims 4-22* are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over *claims 1-39* of copending Application No. 10/833,412. Although the conflicting claims are not identical, they are not patentably distinct from each other because the limitations of *claims 4-22* are broad and are encompassed by the limitations of *claims 1-39* of copending Application No. 10/833,412 and as such would have been obvious to one of ordinary skill in the art to implement the invention of the instant application as defined by *claims 4-22* in order to facilitate a means for an efficient process to provide the network with the subscriber identity via a SIM.

This is a <u>provisional</u> obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Regarding *claims 4, 7 and 20* and its dependent *claims 5-6, 8-10, 12-19 and 21-22* the claims have similar and/or exact limitations as *claims 1, 11 and 21* in that the copending Application No. 10/833,412 details wherein a said device comprises a SIM module capable of receiving identification information about a subscriber from the said device to further transmit this information to the network. The instant application, though the claims are not detailed word-for-word, processes the information in an exact manner.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2.   *Claims 4-22* rejected under 35 U.S.C. 103(a) as being unpatentable over

Vuoristo et al. (U.S. Patent Application 6,603,969 B1) in view of Mills (U.S. Patent

Number 5,915,225).

Regarding *claim 4*, Vuoristo et al. discloses mobile station comprising:

device information; and logic, which, provides the device information to a SIM, receives

from the SIM a communication comprising the device information, and transmits the

communication to a network. See column 11 line 33-67 and column 12 lines 25-32.

The Examiner notes that Vuoristo et al. teaches of a Sim card containing user

identification information, IMSI, which is known to those skill in the art, is retrieved from

a SIM and transmitted to the network for registration purposes. However, because

Vuoristo et al. is silent in detailing wherein information is received from the said SIM and

transmitted to the network.

Mills teaches in column 2 lines 9-20, wherein a network requests information

from a SIM and the SIM re-transmits the requested information back to the network for

processing. See FIGURE 5

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Vuoristo et al to include Mills in order to provide a means for the said SIM to transmit information back to the network.

Regarding *claim 5*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 4*, Vuoristo et al. discloses a said mobile station comprising: location information. See column 11 lines 36-46; and said signal message (3-1), when applied to the processor, provides the location information to the SIM. See column 11 lines 36-46.

Regarding *claim 6*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 4*, Vuoristo et al. discloses column 12 lines 34-44. said signaling message (3-1), receives at least one of settings and logic from the network, and applies the settings and logic to effect configuration.

Regarding *claims 7 and 19*, Vuoristo et al. discloses in column 11 line 33-67 a SIM comprising:

- signaling message (3-1) which receives device information from the terminal device, and, when the terminal device is different than the terminal device used with the previous activation of the SIM (see column 11 lines 33-67), formulates a communication comprising the device information, and causes the

communication to be transmitted to a network, based on the subscriber number.

See column 6 lines 24-37 and column 1 lines 60-67.

The Examiner notes that Vuoristo et al. teaches of a Sim card containing user

identification information, IMSI, which is known to those skill in the art, is retrieved from

a SIM and transmitted to the network for registration purposes. However, because

Vuoristo et al. is silent in detailing wherein information is received from the said SIM and

transmitted to the network.

Mills teaches in column 2 lines 9-20, wherein a network requests information

from a SIM and the SIM re-transmits the requested information back to the network for

processing. See FIGURE 5

Therefore at the time of the invention it would have been obvious to a person of

ordinary skilled in the art to modify Vuoristo et al to include Mills in order to provide a

means for the said SIM to transmit information back to the network.

Regarding *claim 8*, as the combination of Vuoristo et al. and Mills are made, the

combination according to *claim 7*, Vuoristo et al. discloses a SIM comprising: logic

which receives location information from the terminal device, formulates a

communication comprising the location information, and causes the communication to

be transmitted to a network. See column 11 lines 36-46.

Regarding *claim 9*, as the combination of Vuoristo et al. and Mills are made, the

combination according to *claim 7*, Vuoristo et al. discloses a SIM comprising: user

information (see column 6 lines 9-12); and logic which, when applied to the processor,

formulates a communication comprising the user information, and causes the

communication to be transmitted to a network. See column 11 lines 3-27.

Regarding *claim 10*, as the combination of Vuoristo et al. and Mills are made, the

combination according to *claim 7*, Vuoristo et al. discloses a SIM comprising: logic

which communicates the device information to the network via at least one of SMS,

EMS, and MMS. See column 5 lines 48-58.

Regarding *claim 11*, Vuoristo et al. discloses a network comprising:

- a base station subsystem (BSS). See column 12 lines 1-10;

- subscriber information. See column 11 lines 54-67; and

- logic which, when executed by one or more network elements of the network,

    locates subscriber data in response to a communication from a terminal device,

    identifies subscriber services, determines terminal device settings, and

    communicates the settings to the terminal device. See column 12 lines 1-65.

However, because Vuoristo et al. is silent in detailing wherein SIM generated

information is transmitted back to the network.

Mills teaches in column 5 lines 40-46, wherein a network requests information

from a SIM via an SMS message and the SIM transmits the requested information back

to the network via another SIM-generated SMS message for processing.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Vuoristo et al to include Mills in order to provide a means for the said SIM to transmit information back to the network.

Regarding *claim 12*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 11*, Vuoristo et al. discloses a network further comprising:

- one or more network elements to communicate with the terminal device using one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Regarding *claim 13*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 11*, Vuoristo et al. discloses a network further comprising:

- logic which, when executed, communicates configuration logic to the terminal device.

Regarding *claim 14*, Vuoristo et al. discloses a method comprising:

- in response to activation of a SIM in a terminal device, the SIM requesting device information from the terminal device;

- the device providing the device information to the SIM and ;

- the SIM formulating a communication comprising the device information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

However, because Vuoristo et al. is silent in detailing wherein · SIM generated information is transmitted back to the network.

Mills teaches in column 5 lines 40-46, wherein a network requests information from a SIM via an SMS message and the SIM transmits the requested information back to the network via another SIM-generated SMS message for processing.

Therefore at the time of the invention it would have been obvious to a person of ordinary skilled in the art to modify Vuoristo et al to include Mills in order to provide a means for the said SIM to transmit information back to the network.

Regarding *claim 15*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 14*, Vuoristo et al. discloses a method further comprising:

- the SIM formulating the communication according to one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Regarding *claim 16*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 14*, Vuoristo et al. discloses a method further comprising:

- the device providing location information to the SIM. See column 11 lines 36-46;

- the SIM formulating a communication comprising the location information. See

  column 11 lines 3-27; and

- the SIM causing the communication to be transmitted to a network. See column

  11 lines 36-46.

Regarding *claim 17*, as the combination of Vuoristo et al. and Mills are made, the

combination according to *claim 14*, Vuoristo et al. discloses a method further

comprising:

receiving at least one of software, which reads on claimed "settings and logic," from the

network and applying the settings and logic to effect communication of the terminal

device to receive services from the network. See column 12 lines 34-44.

Regarding *claim 18*, as the combination of Vuoristo et al. and Mills are made, the

combination according to *claim 14*, Vuoristo et al. discloses a method further

comprising:

- the SIM formulating a communication comprising user information. See column

  6 lines 11-15; and

- the SIM causing the communication to be transmitted to a network. See column

  11 lines 36-46.

Regarding *claim 20*, Vuoristo et al. discloses a method comprising:

- activating a SIM in a communication device. See column 11 lines 33-53;

- the SIM formulating a communication comprising the location information. See column 11 lines 3-27; and

- the SIM causing the communication to be transmitted to a network. See column 11 lines 36-46.

- the SIM formulating a communication comprising the device information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

Regarding *claim 21*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 20*, Vuoristo et al. discloses a method comprising : the communicating device communicating the message information and causing the communication to be transmitted to a network. See column 6 lines 23-37.

Regarding *claim 22*, as the combination of Vuoristo et al. and Mills are made, the combination according to *claim 20*, Vuoristo et al. discloses a network further comprising:

one or more network elements to communicate with the terminal device using one of SMS, EMS, MMS, and SyncML. See column 5 lines 48-58.

Response to Arguments

Applicant's arguments with respect to *claims 4-22* have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in

this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37

CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later

than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Randy Peaches whose telephone number is (571) 272-

7914. The examiner can normally be reached on Monday - Friday.
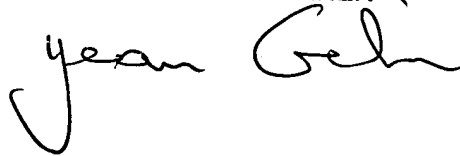
If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Joseph H. Feild can be reached on (571) 272-4090. The fax phone number

for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

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For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

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Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Randy Peaches
February 21, 2007
RP   JEAN GELIN
                                       PRIMARY EXAMINER